

CERTIFICATE OF ELECTRONIC FILING UNDER 37 CFR 1.8

I hereby certify that this correspondence is being electronically filed with the U.S. Patent & Trademark Office on November 2, 2009.

/Nicole Pannoni/

Nicole Pannoni

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

In re Application of:
Bart Alan MELTZER et al.
Application No. 09/173,858
Confirmation No. 4734
Filed: 16 October 1998
Title: **Documents for Commerce in Trading
Partner Networks and Interface
Definitions Based on the Documents**

Group Art Unit: 2178

Examiner: HUYNH, Cong Lac T.

CUSTOMER NO. 22470

MAIL STOP APPEAL BRIEF - PATENTS

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

REPLY TO EXAMINER'S ANSWER

Sir:

This Reply Brief is filed in response to the Examiner's Answer mailed September 2, 2009. This Reply Brief is timely filed within two months of the date of the Examiner's Answer, as provided by 37 CFR 41.39(b) or 37 CFR 41.41(a)(1).

TABLE OF CONTENTS

I. AGREED POINTS	1
II. REPLY TO EXAMINER'S ARGUMENTS.....	1
A. The Examiner Committed Legal Error by Failing to Follow the Standards Set in <i>King Instrument</i> and <i>Mahukar</i>	2
B. Under the Correct Legal Standard, New Declarations and Corroborating Documents Prove Reduction to Practice Before the Publication of McKendrick in September 1998.....	3
1. Reduction to Practice by Inspection on January 4, 1998.....	3
2. Reduction to Practice in Development Before January 21, 1998.	5
3. Reduction to Practice and Demonstrated Use Before July 25, 1998	8
C. Mistaken Application of <i>Res Judicata</i> to Avoid Considering New Evidence Regarding the Level of Skill in the Art	8
D. Non-waiver of Dependent Claims	10
III. CONCLUSION	11

TABLE OF AUTHORITIES

Cases

<i>Cooper v. Goldfarb</i> , 47 U.S.P.Q.2d 1896, 154 F.3d 1321, 1330-31 (Fed. Cir. 1998).....	3
<i>Holmwood v. Sugavanam</i> , 20 U.S.P.Q.2d 1712, 948 F.2d 1236, 1239-40 (Fed. Cir. 1991).....	3
<i>In re Epstein</i> , 32 F.3d 1559, 1568, 31 U.S.P.Q.2d (BNA) 1817 (Fed. Cir. 1994)	9
<i>In re Kumar</i> , 418 F.3d 1361, 1368, 76 U.S.P.Q.2d (BNA) 1048 (Fed. Cir. 2005)	9
<i>In re Payne</i> , 606 F.2d 303, 314-15, 203 USPQ 245 (CCPA 1979)	9
<i>King Instrument v. Otari Corp.</i> , 767 F.2d 853, 861, 226 U.S.P.Q. 402 (Fed. Cir. 1985) cert. denied 475 U.S. 1016 (1986).....	2
<i>Mahukar v. C.R. Bard, Inc.</i> , 79 F.3d 1572, 1578, 38 U.S.P.Q.2D 1288 (Fed. Cir. 1996) (citing <i>King Instrument</i>).....	2

Treatises

1 Chisum on Patents § 3.04 [1][b][v] to [1][c].....	8
---	---

I. AGREED POINTS

The Examiner's Answer acknowledges Appellants' statement identifying the real party in interest, the related appeals or interferences, the status of the claims, the status of amendments after final, the summary of claimed subject matter, the grounds of rejection to be reviewed on appeal and the claims contained in the appendix.

The Examiner's Answer makes no exception to Appellants' jurisdictional statement and grouping of the claims.

II. REPLY TO EXAMINER'S ARGUMENTS

The claimed subject matter includes three independent claims, two for an interface definition for transactions and one for a method for programming transactions that applies the interface definition. For the Board's convenience, the suggested representative claim 15¹ appears in the footnote below.

This is the second appeal. The remaining rejections for the Board to address are under section 103(a). The section 103 rejections should be reversed both because the new declarations and hundreds of pages of corroborating documents (R 421-647) remove McKendrick as a reference and because the new evidence regarding the level of skill in the art proves that McKendrick does not provide either a written description or enabling disclosure of the claimed interface definition.

Three arguments and responses dominate this reply. First, the Examiner argues that our Rule 131 declarations do not prove that a completed product, guaranteed to work, was ready to sell. EA at 19-21. This is an erroneous legal standard for judging whether a declaration proves an actual reduction to practice. Second, the Examiner considers our declarations unreliable, based on a misquotation and a mistake regarding

¹ 1. (rejected) An interface for transactions among nodes in a network including a plurality of nodes which execute processes involved in the transactions, the interface being stored in a computer readable medium, comprising:

a machine readable specification of an interface to transaction processes stored in memory accessible by at least one node in the network, including interpretation information providing a definition of an input document, and a definition of an output document, the definitions of the input and output documents comprising respective descriptions of sets of storage units and logical structures for the sets of storage units.

15. (rejected) The interface of claim 1, wherein the definitions of the input and output documents comprise document type definitions compliant with a standard Extensible Markup Language XML.

the limited relevance of CBL transaction documents to testing the claimed interface definition. EA at 21-22. When we rectify the Examiner's misquotation and confusion about testing the imdesc.xml interface file and using the Slide 30 interface data structure, there is no factual basis for considering the declarations unreliable. Third, the Examiner uses *res judicata* as a reason not to consider new evidence regarding the 1998 level of ordinary skill in the art. EA at 23. This is a clear legal error and contrary to the Board's direction for us to present the new evidence to the Examiner for consideration after the first appeal.

Only nonobviousness issues remain in this appeal, as the Examiner expressly withdrew the section 112 rejection. *Compare* EA 26 *with* AB 35.

A. The Examiner Committed Legal Error by Failing to Follow the Standards Set in *King Instrument* and *Mahukar*.

Both parties have quoted² the same case regarding Rule 131 declarations and reduction to practice. Final OA, R 55-56; AB at 23-24. "[I]n order for there to be a reduction to practice, there is no requirement that the invention when tested be in a commercially satisfactory stage of development." *King Instrument v. Otari Corp.*, 767 F.2d 853, 861, 226 U.S.P.Q. 402 (Fed. Cir. 1985) cert. denied 475 U.S. 1016 (1986). "Some devices are so simple and their purpose and efficacy so obvious that their complete construction is sufficient to demonstrate their workability." *Mahukar v. C.R. Bard, Inc.*, 79 F.3d 1572, 1578, 38 U.S.P.Q.2D 1288 (Fed. Cir. 1996) (citing *King Instrument*).

Despite quoting the legal test, the Examiner erred by requiring that the declarations demonstrate "a complete product that is guaranteed that it worked with testing". EA at 20. Demanding a completed product was a legal error. Reversal for this error follows from the facts discussed below.

² The Examiner's Answer omits the legal standard that the Examiner applied in the Final Office Action. There is no discussion of the applicable legal standard in the Answer.

B. Under the Correct Legal Standard, New Declarations and Corroborating Documents Prove Reduction to Practice Before the Publication of McKendrick in September 1998.

In Appellants' Brief, we presented three alternative proofs of when the claimed interface definitions and method were reduced to practice. All these dates continue to support reversal.

We focus on dates instead of coverage of the claims by the evidence, because only the dates remain at issue in this appeal.³

We remind the Board that the declaration of Kevin Hughes (R 386-401) is by a non-inventor and, as a matter of law, is not subject to the same corroboration requirements as an inventor's testimony. *Holmwood v. Sugavanam*, 20 U.S.P.Q.2d 1712, 948 F.2d 1236, 1239-40 (Fed. Cir. 1991). Moreover, Mr. Hughes' testimony also qualifies to corroborate the inventors' testimony. *Cooper v. Goldfarb*, 47 U.S.P.Q.2d 1896, 154 F.3d 1321, 1330-31 (Fed. Cir. 1998). Of interest, most of the documentary evidence submitted was obtained from Mr. Hughes' personal archives. R 387 ¶¶5.

1. Reduction to Practice by Inspection on January 4, 1998

The easiest date to assign as a reduction to practice is when the imdesc.xml data structure was last modified, on January 4, 1998 at 3:47 a.m. R 393. The *Mahukar* rule authorized the inventors to look at the data structure and conclude from inspection that it would work as claimed. This is an attractive way to decide the appeal, as the Examiner agrees (EA at 21 lines 3-4, 22 at line 19) that this data structure and two similar data structures, one presented by Professor Glushko at a conference (R 678, 394) and the other in the patent application (R 120), prove conception of the claimed subject matter in 1997-98, which is nine months before the September 1998 critical date of the McKendrick reference. The Examiner also agrees (EA at 22, line 6) that the data structures were ready to use as interface definitions, at least for demonstration to an important customer. She does not dispute that they were actually used in the Seitai and

³ Our last appeal failed because the declarations included too little detail. The new declarations are very detailed. They apply the evidence claim-by-claim, as in the Statement of Facts. Coverage of the claims by the evidence is not in dispute. Only testing is at issue.

GSA catalogue interoperability demonstrations (R 396 claim 4, 399 claim 64) months before the critical date.

An excerpt of imdesc.xml demonstrates the simplicity of the data structure and its susceptibility to evaluation by inspection:

```
<!-- imdesc.xml Version: 0.1 -->
<!-- Purpose: marketplace description for Ingram Micro demo -->
<!-- Terry Allen 2 Jan 1998 -->
***
<service.set>
  <service>
    <service.name>Ordering and Fulfillment
  </service.name>
  <service.function.sequence>
    <service.function>
      <doctype from.party="any" to.party="ingram">order.dtd</doctype>
      <doctype from.party="ingram" to.party="any">ack.dtd</doctype>
    </service.function>
  </service.function>
</service.set>
```

An advantage of XML is that it is easy to read. Anyone can see in this code a service named "Ordering and Fulfillment." According to this interface definition, any party sends an order to Ingram Micro and Ingram replies with an acknowledgement.

Appellants asserted (AB at 23) that the *Mahukar* rule should apply and that this elegant data structure should be accepted as reduced to practice once it was placed in memory, without any need for testing. The declarations say in ¶ 8, "we developed multiple versions of data structures that established how to define a document-based transaction interface architecture. We could see that these data structures, when placed in memory, would define an interface to a transaction using one or more input documents and one or more output documents. The interface defined by these data structures was practical and workable ..." R 388. It is persuasive that the last modification date of record for imdesc.xml was January 4, 1998 at 3:47 a.m. (R 393), just two days after its internally documented creation date.

The Examiner did not respond to *Mahukar* or say how much testing would be required to prove imdesc.xml to be workable. It is undisputed that imdesc.xml really did work, so argument about testing is misplaced.

Appellants urge the Board to decide that the imdesc.xml data structure was elegant enough to be reduced to practice by inspection on or before January 4, 1998, when it was last modified.

2. Reduction to Practice in Development Before January 21, 1998.

Even though the Examiner concedes that the evidence shows conception of the claimed inventions in late 1997 or early 1998 (EA at 21 lines 3-4, at 22 line 19), she argues that the evidence does not show a reduction to practice at any time, much less by January 21, because she considers the declarations unreliable.

Most of the factual arguments in Examiner's Answer (EA at 19-22) depend on a misquotation of inventor Terry Allen from Exhibit C. R 424. The truth is that Mr. Allen's memorandum says that the XLL specification was unstable, not that CBL was unstable or unsuitable for interface testing. The two inter-related sentences read:

CBL linking will employ, and if need be augment, the facilities of the XML Linking specification (XLL). As of the date of this document's writing, this specification was still unstable, and the details of the linking attributes in the CBL DTDs should be considered as a sketch. (R 424)

The antecedent basis of this specification is XML Linking specification (XLL). The XML Linking specification (XLL) was under development in 1997-98 by an industry committee, W3C. The Examiner's error was to cut the quote in half and misinterpret what remained, without providing enough context for the reader to spot the mistake.⁴ The Examiner wrote (EA at 19), for instance:

as mentioned in the office action 10/9/08, the article "Common Business Language" in Exhibit C of one of the inventors, Terry Allen, dated in December 5, 1997 stated that the early version of CBL is unstable and merely a sketch as in December 1997. This part is repeated as follows:

"Also, as shown in Exhibit C, the article "Common Business Language (CBL)" dated December 5, 1997, the early version of CBL is unstable and merely a sketch, "As of the date of this document's writing, this specification was still unstable, and the details of the linking attributes in the CBL" DTDs should be considered as a sketch" (emphasis added)"

⁴ The Examiner must have done this inadvertently, as it is a fairly subtle, but enormously important distinction. We attempted to contact the Examiner about this before filing our reply, but she did not return our calls.

This misquotation and the implicit assertion that the "specification" was CBL became the lynch pin of the Examiner's Answer. EA at 19-22.

The reason that the XLL specification was unstable was that Version 1.0 of XLink Requirements was still 14 months away⁵ when Mr. Allen wrote Exhibit C. But stability of the XLL specification doesn't really matter, because there is no evidence of record that testing and acceptance of the claimed interface definitions depended in any way on the XLL specification.

Similarly, testing and acceptance of the claimed interface definitions did not depend on the status of the Common Business Library (CBL). The CBL held a set of XML documents designed for various transactions, to spare companies from development of and inconsistency among purchase orders, acknowledgements, etc.⁶ One of skill in the art will recognize that dtd stubs could have been used for testing the claimed interface, without any need for full CBL documents, much less any need for a stable library of CBL documents.

Appellants tried to use the new declarations, before appeal, and the Statement of Facts, on appeal, to head off any confusion between CBL and the claimed interface definitions. From our Statement of Facts, AB at 4-5:

Related to the claimed technology, but not subject to patent protection and dedicated to royalty-free public use, is a collection of business document forms called the "common business library", abbreviated CBL. (R 175). See, www.xCBL.org.⁷

The claimed interface definition technology does not depend on CBL or necessarily even on XML. Conversely, the CBL documents can be used for e-commerce processes that do not incorporate the claimed interface specifications. (Decls. § 10, R 389). CBL documents could be used by

⁵ Historically, version 1.1 of CBL was publically released in September, 1998, months before the draft XLink requirements in February, 1999. The initial version 1.0 Recommendation for the XML language was not published until February 1998, two months after Mr. Allen's memorandum.

⁶ See, original application (R 121-24); Meltzer and Glushko, XML and Electronic Commerce: Enabling the Network Economy, SIGMOND Record, Vol. 27, No. 4, 21-24 (Dec. 1998) (Ex. O, R 739-43).

⁷ The xCBL family of transaction documents has reached version 4.0, under the control of a non-profit organization that has outlived Veo and Commerce One. Development of new versions of xCBL continues even today. See xCBL.org.

processes that use remote procedure call interfaces, instead of document-style interfaces.

The Examiner did not challenge these undisputed facts.

In the original application (R 119-121), "Business Interface Definitions" (BIDs) are explained and an exemplary BID is listed. R 120. By inspection, one of ordinary skill can see that testing the pre-application interface definitions (imdesc.xml and Slide 30) or the exemplary BID required only a few document type definitions (dtd's), such as an input purchase order and an output acknowledgement. Looking at imdesc.xml, it is apparent that reduction to practice did not depend on whether the referenced dtd files even defined CBL transaction documents, so the reliability of the declaration testimony does not depend on stability of CBL or the XLL specification.

The declarations, ¶ 16, tie together many exhibits that explain why imdesc.xml was tested and reduced to practice before January 21, 1998.

Before January 21, 1998, we had sufficiently worked with imdesc.xml to recognize and understand that it would serve its intended purpose of defining a document-based transaction interface that can include a series of related document exchanges. This file was one of many that were under development. The "index.html" (Ex. C) confirms that these files were tested during development. Exhibits D, E and H demonstrate the availability of the supporting files called for by the demonstration plan. By comparison of Exhibits D, E and H to the demonstration plan (Ex. F), one sees that all of the files listed as desired for the demonstration were available before January 21, 1998.

R 393 ¶16; see *also*, R 390-93 ¶¶13-15 (further explaining preparations). Again, the reliability of this testimony cannot depend on the stability of CBL or XLL, because "recognizing and understanding" that imdesc.xml would work as an interface definition did not depend on CBL or XLL.

When we rectify the misquotation of Mr. Allen's statement and the misunderstanding of how to test imdesc.xml, it is apparent that the Examiner's suspicion about the reliability of the declarations is mistaken, arbitrary and clearly erroneous. The Examiner should be reversed regarding the effectiveness of the declarations to remove McKendrick as a reference.

3. Reduction to Practice and Demonstrated Use Before July 25, 1998

July 25, 1998 is a third date by which the Board can determine that the claimed interface definition was reduced to practice. That is the day that Professor Glushko gave a talk at the Hass School of Management in Berkeley using a set of slides (R 648-80) that are in evidence. The Examiner's argument (EA at 20 lines 7-8) is that the slide presentation is just slides and computer code. Our response is that the slides corroborate the declarations. For inventions embodied in software that runs on hardware, the computer source code is excellent corroborating evidence, certainly good enough to require the Examiner to accept the testimony in the declarations.

The declarations and Slide 30 prove the existence of interface definition data structures that the Examiner agrees embody the claims. See, EA at 21 line 3-4, at 22 line 19. The declarations and Slide 31 further prove that the interface definition technology was used in two demonstration projects, namely Seitai and the GSA catalog interoperability, before July 25, 1998. R 396 claim 4, 399 claim 64. One of ordinary skill in the art will appreciate that an interface definition is a starting point for transaction processing. Accessing the interface definition precedes transaction processing, so use of the interface definition in two demonstration transaction processing projects conclusively proves reduction to practice. This proof of reduction practice is more than two months before the critical date for removing McKendrick has reference. Without McKendrick, the Examiner's section 103(a) rejections fail.

C. Mistaken Application of *Res Judicata* to Avoid Considering New Evidence Regarding the Level of Skill in the Art

The Examiner's *res judicata* argument (EA at 23) fails to distinguish between new evidence related to reduction to practice, on one hand, and the new evidence related to the 1998 level of ordinary skill in the art, on the other hand. The Examiner's Answer erroneously rejects the declaration testimony about reduction to practice and then ignores the other new evidence about the level of ordinary skill in the art. EA at 23. This is a legal error because it misapplies *res judicata*, as more fully explained in our opening brief. AB at 24. This Board specifically directed Appellants to present the new evidence related to the level of skill in the art to the Examiner (R 28, 31 ¶13), presumably for the

Examiner to consider. Both sets of new evidence needed to be evaluated by the Examiner.

The Examiner's application of *res judicata* and failure to consider the new evidence is reversible error because the new evidence reveals a low level of skill in the art, in the months before and after the Recommendation for XML version 1.0 was published. The new evidence also reveals that Microsoft, in the section of McKendrick on which Examiner relies (AB at 9; Exs. R-U; R 791-848), must have been advocating use of a different XML technology, not the claimed interface definitions. In 1998, the evidence undisputedly shows that Microsoft was advocating use of XML with remote procedure call technology for e-commerce. *Id.*

The legal rule that applies to McKendrick is that a reference used for a section 103 rejection must include an enabling disclosure. A newspaper article, for instance, only qualifies as a reference if it includes both a written description and an enabling disclosure. More generally, printed publications cited as prior art must be enabling. *In re Kumar*, 418 F.3d 1361, 1368, 76 U.S.P.Q.2d (BNA) 1048 (Fed. Cir. 2005); *In re Epstein*, 32 F.3d 1559, 1568, 31 U.S.P.Q.2d (BNA) 1817 (Fed. Cir. 1994); 1 Chisum on Patents § 3.04 [1][b][v] to [1][c], citing, *In re Brown*, 329 F.2d 1006, 141 USPQ 245 (CCPA 1964); *In re Payne*, 606 F.2d 303, 314-15, 203 USPQ 245 (CCPA 1979) ("References relied upon to support a rejection under 35 U.S.C. 103 must provide an enabling disclosure, i.e., they must place the claimed invention in the possession of the public")

McKendrick⁸ cannot be considered an enabling disclosure because there is not enough written description to understand what kind of XML technology Microsoft was suggesting. The Examiner makes a fatal admission in her discussion of McKendrick, which underscores the importance of the new evidence about Microsoft's 1998 XML technology. She admits (EA at 24 line 19) that one cannot tell from McKendrick whether

⁸ The 53 words of McKendrick that the Examiner considers to be an enabling disclosure read as follows:

" 'Customer services are now migrating to Web sites from call centers and physical locations,' states a report from Microsoft Corp. 'And, because most of these business applications involve manipulation and transfer of data-such as purchase orders, invoices, customer information and appointments XML will allow a rich array of business applications to be implemented.' " R 192 (underlining added).

Microsoft was advocating use of the XML remote procedure call technology. The Examiner's Answer says, "There is no indication that XML mentioned in McKendrick should be XML-RPC technology as argued." *Id.* It follows that the Examiner has admitted that one of ordinary skill cannot tell from McKendrick whether Microsoft's remote procedure call technology or Commerce One's interface definition technology is referred to in the very brief newspaper report. This is an admission that McKendrick does not provide a written description of either the claimed technology or the alternative Microsoft technology. Without any written description, there cannot be an enabling disclosure. Therefore, the Examiner's legally mistaken application of *res judicata* is reversible error.

D. Non-waiver of Dependent Claims

The Examiner did not respond to Appellants' detailed analysis of dependent claims (AB at 9-19, 26-34), so no rejoinder is required. Note that we grouped the claims in this appeal differently than in the first appeal, so the Board's prior opinion is not useful in addressing the dependent claims. The positions taken in the opening brief are not waived and should prevail by default.

III. CONCLUSION

In view of the foregoing, Applicants ask that this honorable Board reverse the Examiner's rejections of the claims. In addition, it is submitted that all claims that are the subject of this examination are now allowable, and a notice of intent to issue a patent is respectfully requested.

The Commissioner is hereby authorized to charge any fee determined to be due in connection with this communication, or credit any overpayment, to our Deposit Account No. 50-0869 (File No. OIN 1004-1).

Respectfully submitted,

Dated: November 2, 2009

/Ernest J. Beffel, Jr./
Ernest J. Beffel, Jr., Reg. No. 43,489
Attorney for Patent Owner

HAYNES BEFFEL & WOLFELD LLP

P.O. Box 366
637 Main Street
Half Moon Bay, CA 94019
Telephone: 650.712.0340
Facsimile: 650.712.0263